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Application Number: 09/396,530 / Group Art Unit: 3711

Filing Date: 9/15/99

Examiner Name: William Pierce

Inventors: Randall Addington et al.

Attorney Docket No.: 99-1002

Title: Method For Improving Bowler's Control

Assistant Commissioner of Patents
Washington, D.C. 20231

APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

A Petition to make Special Under 37 CFR 102(c) has been granted in this Application and has been granted in parent application 09/130,905, filed 08/07/98.

Appellants Reply Brief (submitted in three copies)

Appellant has included a separate request for an oral hearing under Rule 1.194

I.

Reply To Paragraph (3) Status of Claims

Section III., on page 1 of the Appeal Brief for the status of the claims, states.

Claims 14 - 30 and 3(amended) and 4(amended), are pending in this case.

Examiner's Answer to the Brief's statement, given above, is.

The statement of the status of the claims contained in the brief is correct.

Accordingly, Claims 14-30 and 3(amended) and 4(amended), are the claims which are the subject of this appeal. However, Examiner has not finally rejected claim 3(amended) or claim 4(amended) and the present status of claims are.

Claims 14-30 are finally rejected. Claims 3(amended) and 4(amended) have not been rejected or allowed.

II.

Reply To Paragraph (5) Summary of the invention

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Examiner states.

The summary of the invention contained in the brief is deficient because Appellant's Summary is argumentative and is not limited to the structure of the claimed invention.

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37CFR1.192(5) *Appellant's Brief. Summary of invention*, requires.

A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

15

Appellants have followed the above directions by providing, "a concise explanation of the invention defined in the claims," and by referring to the specification by page and line number and by reference characters in the drawings. The claims in this appeal are claims 14 to 30, and 3(amended) and 4(amended), and Appellant has provided a concise explanation of the invention as claimed in claims 14 - 30 and 3(amended) and 4(amended). In addition, Appellant's Brief in Section VIII., discusses each of the claims, element by element, with regard to specification and drawings, to show the claims are supported by the specification under the 1st Paragraph of 35 U.S.C. 112. "Summary," means "covering the main points succinctly." See Webster's New Collegiate Dictionary 1973 page 1166. Appellant has met the accepted meaning of Summary," by succinctly covering the main points of claims 14 - 30 and 3 and 4.

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5 To "argue," means to give reasons for or against. Appellant believes
Examiner's statement that "Appellant's Summary is argumentative" is irrelevant and
misplaced. The invention, as defined in the claims incorporates the knowledge of one
skilled in the art, known at the time the application was filed, and the specification
10 incorporates that knowledge of one skilled in the art. Accordingly, when referring to
the specification as directed by Rule 1.192(5), it is necessary to show that knowledge
did exist at the time the application was filed. Appellant has met that burden of showing
that knowledge of one skilled in the art existed at the time the application was filed by
reference to U.S. Patent 4,371,161 and the Declarations of the inventors and
15 additionally by reference to the statement made by Examiner. As the U.S. Patent
shows that knowledge of one skilled in the art, by itself, Examiner may have mistaken
the reference to Examiner's own statement of what was the knowledge of one skilled in
the art, as "argumentative."

Examiner's statement. "Examiner's position with respect to these remarks is set
20 forth in the examiner's response to appellant's remarks. " is not intelligible to Appellant
as there is no "remarks," in the Brief and under the Rules, Examiner is responding to
Appellants' Brief. Appellant requests clarification of Examiner's above statement and
an opportunity to reply under Rule 1.193.

25 Appellant believes the "Summary," as presented in the Brief, meets the
requirements of Rule 1.196(5).

Reply To Paragraph (6) Issues

A.

Issue 4

Issue 4 was created by the Examiner's unlawful rejection of Appellants'

10 Declarations. in Paragraph 6 of Paper No. 6. The fact evidence in these Declarations
were placed in the record by applicants' attorney who incorporated these Declarations
within the *Remarks* to the Rule 111 Amendment filed 5/19/00 (see Rule Amendment
filed 5/19/00, page 12, lines 5-7, page 20, lines 15 to end of page, page 21, lines 12-
13, 18-19, page 26, lines 18-21), and adopted them as his own, in support of the
15 argument made in the *Remarks* for allowance of claims 14-30 and 3(amended) and
4(amended).

Examiner's assertion the Declarations "are insufficient to overcome the
rejections of claims 14-30" was not supported by substantial evidence and was
20 unlawful. Examiner's conclusions 1 to 5, serving as the sole support for his rejection of
the Declarations are as follows

- 1) The Declarations do not refer to the individual claims of
the application.
- 2) While the Declarations do refer to claims, these claims
25 have been cancelled and are no longer in issue.
- 3) There is no showing the objective evidence is

5 commensurate with the claims.

4) The Declarations offer opinions of the inventors and not facts which can be used as a basis to overcome the grounds of rejection, and

5) The rebuttal evidence of non-obviousness fails to

10 outweigh the evidence of obvious.

Examiner's conclusions 1 to 5, are deficient and his rejection of the evidence in the Declarations unlawful, because he does not reveal the facts or law, relevant to those conclusions and has failed to show any evidence, substantial or otherwise, supporting those conclusions, as required by the Administrative Procedure Act Standard for a Patent Office rejection (hereinafter "APA Standard"). The APA Standard requires a fact based conclusion based on substantial evidence. Dickenson v. Zurko 50 USPQ 2d 1930, 193, and which asks whether a reasonable mind might accept a particular evidentiary record as adequate to support a conclusion. Zurko, at 1935. See 20 In Re. Kotzab 217 F. 3d 1365 (Fed. Cir 2000) requiring the rejection be "based on particular findings." at 1370. See In Re. Gartside 203 F.3d 1305 (Fed. Cir. 2000) requiring that a rejection be based on substantial evidence meaning "...such relevant evidence as a reasonable mind might accept as adequate to support a conclusion..." at 1312; and that a Patent Office decision, "must explicate its factual conclusions 25 enabling... [the Court...] to verify readily whether those conclusions are indeed supported by 'substantial evidence'...." at 1314 Underlining added).

5 Until Examiner shows what "substantial evidence" he uses to support his
conclusions 1 to 5, above. Examiner has failed to meet the APA Standard and
Appellant is denied the opportunity to test Examiner's rejection of the inventors'
Declarations to determine if supported or not supported by substantial evidence.
Examiner's rejection of claims 14-30 and 3(amended) and 4(amended) Declarations.
10 must be by consideration of the facts in the Declarations, as part of the substantial
evidence under the APA Standard.

 Until Examiner shows by substantial evidence why the facts presented in the
Declarations, adopted and incorporated in the *Remarks* in the Rule 111 Amendment,
15 by applicants' attorney in support of the allowance of claims 14-30 and 3(amended)
and 4(amended), does not overcome the rejection of these claims under 35 U.S.C.
102(b). Examiner has not supported his conclusions the Declarations are "insufficient,"
by substantial evidence and his rejection of the Declarations should be vacated.

20 Issue 4 may be addressed as a part of Issue 3 dealing with anticipation by
Marinese of claims 14-30 and 3 and 4, under 35 U.S.C. 102(b); provided, however,
Examiner meets the APA Standard, with respect to the whole record, including the
Declarations, by showing by substantial evidence why the facts, including the
Declarations, as argued by applicants' attorney in the *Remarks*, are, as stated by
25 Examiner, "insufficient to overcome the rejections of claims 14-30 [and 3(amended)
and 4(amended)]..."

Issue 2

Issue 2 is whether the Examiner has supported, or should be made to support, his rejection of claims 14-30 and 3 and 4 under 37 CFR 1.83(a), as required by the APA Standard. See Brief, Argument No.2, page 31-34, and in particular, Appellants' argument stating Rule 1.83(a) is to be read under 35 U.S.C. 113, requiring a drawing be provided where necessary for an understanding of the subject matter sought to be patented. In particular, Examiner should be made to support his rejection as required by the APA Standard by being made to reveal what claimed steps in claims 14-30 and 3(amended) and 4(amended), he believes are not shown in the drawings and by being made to reveal the standard he imposes under Rule 1.83(a) in deciding the drawing did not show every feature of the invention as claimed in claims 14-30 and 3(amended) and 4(amended). In Paragraph 2 of Paper No. 6, Examiner objected to the drawings under 37CFR 1.83(a), stating,

... the steps of claims 14-30 must be shown or the feature(s) cancelled from the claims(s).

While Examiner used the word "objected to," Examiner plainly is rejecting claims based on Examiner's own perceived legal standard for Rule 1.83(a) and what Examiner perceives it requires the drawings show compared to the claimed subject matter. It is clear Examiner believes elements of claims 14-30 and 3(amended) and

5 4(amended), are not shown in the drawing as Examiner believes Rule 1.83(a) would
require. While, at the same time, Examiner fails to specify what claim steps are not
shown in the drawings, or more important, the legal standard Examiner perceives set
by Rule 1.83(a), that makes his expressed position legally supportable under the APA
Standard. Up to now, Examiner has not revealed that legal standard or the claim steps
10 asserted by Examiner as not shown in the drawings. Accordingly, basic to Issue 2 is
what Rule 1.83(a) means in relation to what claim elements or steps one skilled in the
art would understand as shown in the drawings.

For example, Rule 1.83(a) would not require the drawings show details known to
15 those skilled in the art such as each of the well known separate related steps within a
claimed step reciting "transferring data from a disk store to ram memory."
accomplished as is well known by a computer's central processing unit. A block
drawing identifying the step, "transferring data from a disk store to ram memory,"
would be understood by one skilled in the art as including all of the subordinate steps
20 within that block, as would be known to those skilled in the art as involving the central
processing unit, the data busses and memory allocation methods and the processes of
the disk drives, related to the data transfer. Because Examiner's position substantively
rejects claims 14-30 and 3(amended) and 4(amended), while failing to meet the APA
Standard, Issue 2 should remain in this Appeal.

25 Unless Examiner reveals his Rule 1.83(a) standard, Appellants are denied the

5 opportunity to test the standard to determine if it has the support of law.

IV.

Reply To Paragraph (8) Claims Appealed

10 The claims in this Appeal are 14-30 and 3(amended) and 4(amended). While
Examiner has twice rejected claims 14-30, and rejected claim 3 and 4 once. Examiner
has not rejected claim 3(amended) or claim 4(amended) which remain in this Appeal, as
not finally rejected and not allowed.

V.

15 Reply To Paragraph (10) Grounds of Rejection

A.

Appellants' Brief, Argument No. 1, Page 7 et seq., shows the claims 14-30 and
3(amended) and 4(amended), are supported by the specification as required under 35
20 U.S.C. 112.

B.

Appellants' Brief, Argument No.3, Page 35 et seq., shows the claims 14-30 and
3(amended) and 4(amended), are not anticipated by Marinese under 35 U.S.C. 102(b).
25 and Appellants' make the following statement in reply to Examiner's Answer.

Marinese, Patent No. 3,046,561, cannot anticipate claims 14-30 and 3(amended) and 4(amended), because LIFT, as recited in claim 14, paragraph d, and as a part of the claimed method, is not mentioned anywhere or discussed or disclosed in any form, in Marinense. Lift is supported in the specification as shown in the Brief on page 13, lines 15 to end, and on page 14. Lift is described in the specification, for example, on pages 4 and 5, and on page 13, lines 19-23, of the application. Lift, as recited in the claims is supported in the specification, and is well known and understood by those skilled in the art, as explained in the Brief, see last paragraph on page 13 and first paragraph on page 14.

As recited in claim 14, paragraph d, lift occurs when,

releasing said finger pad of a bowler and said finger pad shield from said finger hole of a bowling ball by applying a first force from said finger pad of a bowler in a first direction against said first surface of said finger pad shield, through said finger pad shield to said second surface of said finger pad shield, against said interior surface of said finger hole of a bowling ball, to lift said bowling ball and producing a second force in a second direction, from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield.

5 Lift, as well known to those skilled in the art, means the spin imparted to the ball
by the force of the fingers in the finger hole when the ball is released. See Brief, Page
13 to end and page, and 14. In particular, see Patent 4, 371,163, explaining lift as how
the middle fingers are used to rotate the underside of the ball upward in an effect called
"lift," upon release, col. 3, lines 47-55, after removing the thumb, col. lines 52-54, col. 4,
10 lines 14-17.

No where in any part of the sole reference used by Examiner to reject claims 14-
30 and 3(amended) and 4(amended) is there any mention of "lift." (See Marinese,
Patent 3,046,561). Marinese does not mention "lift," any where in the patent in
15 connection with his disclosed invention or otherwise. Marinese does not show or
describe "lift" or any use of "lift," or interest in "lift," or anything like "lift." Marinese
doesn't use or refer to "lift" because "lift" is not part of Marinese's disclosure and it is
inoperative to control release and lift, see Brief page 38, lines 15-21, Section D, page
39, lines 14-24, Section F, referring to the *Remarks* in appellants' Rule 111
20 Amendment, submitted 5/19/2000 and the Declarations incorporated into the *Remarks*
and adopted by Appellants' attorney. Accordingly, Marinese cannot anticipate claims
14-30 and 3(amended) and 4(amended).

(2)

25 On page 4, lines 7 to 9, Examiner states,

 The apparatus of Marinese transmits forces applied by the

5

bowlers fingers to the finger pad and then to the bowling ball
to control the release and the lift place (sic)
on the ball as recited in steps c-f.

10

However, Examiner has misrepresented Appellants' claims. Contrary to
Examiner's above representation of the claims, Claim 14, paragraphs d and e, recite,

15

d. releasing said finger pad of a bowler and said finger pad
shield from said finger hole of a bowling ball by applying a
first force from said finger pad of a bowler in a first direction
against said first surface of said finger pad shield, through
said finger pad shield to said second surface of said finger
pad shield, against said interior surface of said finger hole of
a bowling ball, to lift said bowling ball and producing a
second force in a second direction, from said interior surface
of said finger hole of a bowling ball, against said second
surface of said finger pad shield:

20

25

e. said step d, of releasing said finger pad of a bowler and
said finger pad shield from said finger hole of a bowling ball,
includes the step of receiving said second force in said
second direction, from said interior surface of said finger
hole of a bowling ball, against said second surface of said
finger pad shield, through said finger pad shield to said first

5 surface of said finger pad shield and over said contact area
made between said finger pad of a bowler and said first
surface of said finger pad shield:

(Underlining added).

10 The above recitation describe the steps of releasing the bowling ball ... to lift the
bowling ball and in the step d, in,

releasing the bowling ball, receiving said second force in
said second direction, from said interior surface of said
finger hole of a bowling ball, against said second surface of
15 said finger pad shield, through said finger pad shield to said
first surface of said finger pad shield and over said contact
area made between said finger pad of a bowler and said first
surface of said finger pad shield.

20 As shown by Appellants, Marinese does not show use of the Marinese thumb
pad to release the bowling ball by applying a force from the bowler's finger to lift the
bowling ball and Marinese does not meet the recitation of Claim 14, as reproduced
above. See Brief, page 38, lines 15-21, Section D, and 39, lines 14-24, Section F,
referring to the *Remarks* made in Appellants' Rule 111 Amendment, filed 5/19/2000
25 and the Declarations of R.A. Addington filed 5/19/2000, Paragraph 4, Page 2, and
W.Robert Addington, DO, filed 5/19/2000, of record in the application and incorporated

5 into the Remarks by Appellants' attorney in the Rule 111 Amendment filed 5/19/2000.
Page 12, lines 5-7.

(3)

On page 4, lines 9 to 13, Examiner states.

10 While these "applying a first force", "producing a second
force" and how these forces interact with the finger pad and
the bowling ball are not specifically disclosed [in Marine].
it is noted that in method claims, the prior art anticipates if
the device carries out the method during normal operation.

15 (See MPEP2112.01).

However, as Appellants' have stated in the Brief, Page 36, "Rejections Based On
Inherency,"

20 In relying upon the theory of Inherency, the examiner must
provide a basis in fact and/or technical reasoning to
reasonably support the determination that the allegedly
inherent characteristic necessarily flows from the teachings
of the applied prior art. Ex parte Levy, 17 USPQ2d 1461,
1464 (Bd. Pat. App. & Inter. 1990). See MPEP, R3, July
1997, SECTION 2112 Requirements of Rejection Based on
25 Inherency; Burden of Proof, page 2100-47.

Examiner has not shown in a factually based decision bound up in a record

5 based factual conclusion supported by substantial evidence, as required by the APA Standard, how, as Examiner claims (See page 4, lines 13 -15), how the device of Marinese,

in its normal and usual operation, would necessarily perform the method claimed...

10 and Examiner's rejection based on "Inherency," must be vacated.

(4)

Examiner refers to *In re Huck*, 114 USPQ 161, 163 (CCPA 1957) as legal precedent for the proposition, as stated by Examiner on Page 4, lines 15-19.

15 While the discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using.... Such is not the case here since the apparatus of Marinese and the instant invention are being used to transmit forces from bowlers
20 hand to a bowling ball;

however, Examiner has failed to show how Marinese discloses the method recited in Claims 14-30 and 3(amended) and 4(amended). (See V., B., (2) above. See Brief, Pages 40, 41 Section IV.).

25 VI.

Reply To Paragraph (11) Response to Argument

5

(1)

Examiner's objection to the drawings in this appeal (See Paper No. 6, Paragraph 2) is Issue 2 in this Appeal. (See Pages 6 and 7, above). Appellants repeat their statement made in the Brief on Pages 31 to 34 and above in this Rebuttal on Pages 7-9.

10

(2)

Examiner's statement "the specification does not discuss a 'first force' and a 'second force'" has been addressed in the Brief, Pages 25 to 30. Examiner's rejection on the grounds that "first force" and "second force" are not recited in the specification has been shown in the Brief, Pages 25 to 30 and particularly on Page 27, from the beginning of the first full paragraph to the end of claim 14 on Page 29 to be a clear error and a clear misrepresentation of the claim recitation. Examiner misrepresents the claimed invention by misrepresenting the "first force" and "second force" as separate independent elements in the claim requiring support in the specification. (See V.. B.. (2) above for the full text recitation of "first" and "second.") One skilled in the art would recognize "first force" and "second force" merely serves as a way of identifying in the claim, the force from the bowler's finger to the ball and the force from the ball to the bowler's finger, which are fully supported by the specification and would be well known to those skilled in the art of bowling and should be to Examiner. (See Brief, Page 27, from the beginning of the first full paragraph to the end of claim 14 on Page 29).

It is wrong, for the Examiner to reject the claims, in view of the Declarations made by the Appellants and in view of the disclosure of Patent 4,371,163, col. 4, lines 7-16, which shows these recited forces from the bowler's finger to the ball and from the ball to the bowler's finger, as well known to those skilled in the art, and it is wrong for Examiner to take the adjectives "first" and "second" out of the context of the modified nouns, where the unmodified nouns "force from said finger pad of a bowler" and "force in a second direction, from said interior surface of said finger hole of a bowling ball," are clear in the claim context and clearly supported in the specification, and reject the claims as not supported under 1st Paragraph, 35 U.S.C. 112.

(3)

In rebuttal to Examiner's Answer, dismissing the Declarations under 37 CFR 1.132, as "insufficient," See Page 4, Paragraph 4. Appellants rely on the Brief, Argument 4 made to Issue 4, and the rebuttal statements made for Issue 4 on Pages 4 to 7, above, and the following.

A Rule 1.132 Declaration permits a fact declaration traversing a U.S. Patent, or facts within personal knowledge of an examiner or the mode or capability of operation attributed to a U.S. Patent, whenever any claims of the application are rejected on reference to that U.S. Patent or personal knowledge. Examiner's statements.

1) The Declaration do not refer to the individual claims of the application.

5 2) While the Declarations do refer to claims, these claims
have been cancelled and are no longer in issue,

3) There is no showing the objective evidence is
commensurate with the claims,

10 4) The Declarations offer opinions of the inventors and not
facts which can be used as a basis to overcome the grounds
of rejection, and

5) The rebuttal evidence of non-obviousness fails to
outweigh the evidence of obvious.

15 are misrepresentations or a misreading of the law or irrelevant.

 The statement, "The Declaration do not refer to the individual claims of the
application", is a misreading of the law, a misrepresentation and irrelevant. The Rule
1.132 traverse is not directed to any claims but to what the examiner says is shown in
20 the referenced patent or in his personal knowledge. Rule 1.132 requires a claim be
rejected with reference to that traversed patent or traversed personal knowledge. There
is no requirement the rejected claims still be in the application. The traverse is a fact
based rebuttal of the referenced patent or referenced personal knowledge of the
Examiner as that referenced patent or referenced personal knowledge is applied to
25 Appellants' claims.

5 The statement, "While the Declarations do refer to claims, these claims have been cancelled and are no longer in issue," is irrelevant. As stated above, the traverse is fact based to the facts of the referenced patent or referenced personal knowledge, and not the claims, whether rejected or pending.

10 The statement, "There is no showing the objective evidence is commensurate with the claims," is irrelevant because no "objective" evidence or evidence of "secondary considerations," such as success in the marketplace, has been offered.

15 The statement, "The Declarations offer opinions of the inventors and not facts which can be used as a basis to overcome the grounds of rejection, reflects a correct reading of the requirements placed upon Rule 1.132 Declarations but is wrong about the content of the Declarations. However, it is worth noting that it is irrelevant who makes the Declarations, whether the inventors, the attorney or anyone else, as long as the Declarations are fact based, as any one capable of making a credible statement of the given facts, may be a declarant, including the inventors. The Declaration of W. Robert Addington, DO, is a fact statement given by a Board Certified Physician about the mode or capability of operation attributed to the U.S. Patent 3,046,561 Marinese reference as used for the rejection of the claims, and clearly within the permitted bounds of Rule 20 1.132. Examiner has not shown where this Declaration of W. Robert Addington, DO are "opinions and not facts," and this statement by the Examiner with reference to the Declaration of W. Robert Addington, DO, fails to meet the APA Standard and is 25

5 irrelevant.

10 Similarly, the Declaration of R.A. Addington is a fact statement about the mode or capability of operation attributed to U.S. Patent 3,046,561 which is the Marinese reference as used for the rejection of the claims, and is clearly within the permitted bounds of Rule 1.132. Examiner has not shown where this Declaration of R.A. Addington, are "opinions and not facts," and this statement by the Examiner with reference to the Declaration of R.A. Addington, fails to meet the APA Standard and is irrelevant.

In summary, these Declarations traverse the Examiner's version of the mode of operation and capability of the Marinese reference as applied by Examiner to reject claims, on the grounds of Inherency, on what Examiner calls its "method during normal operation," and in particular Examiner's explanation of how he believes the Marinese thumb cover and the forces it produces with the other fingers, interact with the bowling ball. Appellant is within the bounds of Rule 1.132 to bring a fact based declaration to traverse the Examiner's version of the Marinese facts and to show the Examiner's understanding of Marinese's operation or capability is wrong

Respectively, submitted.



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